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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,601	02/28/2002	Akihiro Kuroda	3094-39	7638
29540	7590	02/16/2005	EXAMINER	
PITNEY HARDIN LLP 7 TIMES SQUARE NEW YORK, NY 10036-7311			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No.	Applicant(s)	
	10/070,601	KURODA ET AL.	
	Examiner	Art Unit	
	Gina C. Yu	1617	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED \_\_\_\_\_ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 31 January 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: none.
- Claim(s) objected to: 10, 11, 13, 14, 16-18, 22 and 23.
- Claim(s) rejected: 1, 3-9, 12, 15, 19-21, 24 and 25.
- Claim(s) withdrawn from consideration: none.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s) \_\_\_\_\_.
13. ☒ Other: Interview Summary.

  
**SREENI PADMANABHAN**  
 SUPERVISORY PATENT EXAMINER

Continuation of 5:

Applicant's reply has overcome the following rejection(s): Rejection made under 35 U.S.C. § 112, second par.; rejection made under 35 U.S.C. § 103 (a) over Gers-Barlag et al. (6436413) in view of Sakuta et al. (4970252); obviousness rejection made over Sakuta (6503519) in view of Sakuta ('252); obviousness rejection made over Suzuki et al. (6395857) in view of Sakuta ('252).

Continuation of 11:

Examiner maintains the rejection for the reasons as explained in the previous Office action dated July 14, 2004. Applicants assert that one of ordinary skill in the art would not have been motivated to combine Suzuki with Sakuta allegedly because methytris(trimethylsiloxy)silane (M3T) was merely used as a diluent in polymerization rather than a cosmetic component. Examiner respectfully disagrees. Also taught in the Sakuta reference is the equivalence of M3T with other low-viscosity silicone oils that are well known in cosmetic art, including cyclic dimethylpolysiloxane, methylpolysiloxane, methylphenylpolysiloxanes, which are also used in Suzuki. It is viewed that substituting one low viscosity silicone with another that are taught in Sakuta would have been obvious to the skilled artisan. There is sufficient motivation to modify the Suzuki cosmetic composition with a reasonable expectation of successfully producing a similar cosmetic product.

Applicants also assert that M3T provides "improved cosmetic properties" over other low-viscosity silicone oils. The comparison data in specification pp. 36-38 were fully considered. While it is not clear what "D4" component is, nonetheless it is noted

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that the specification shows evaluation results by 10 panelists who reported that the compositions comprising M3T provides "durability for coverage " and "fresh feel" than compositions comprising D5 (decamethylcyclopentasiloxane) by 42 and 39, compared to 29 and 16, respectively. Examiner views that the evidence does not sufficiently to show nonobvious or unexpected results. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, M3T and decamethylcyclopentasiloxane are art-recognized substitute for each other. Examiner views that the minor difference in the reported sensory opinions may be due to different properties of the M3T compound itself, which would naturally flow from using it in a cosmetic composition as motivated by the combined teachings of the references, rather than a greater than expected result. See MPEP § 716.02. Examiner also takes the position that opinion evidence alone cannot be given probative value to determine the ultimate legal conclusion of whether the present invention is an obvious variation of the prior arts. See MPEP § 716.01(C).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner